



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,890	12/31/2001	Douglas A. Nagan	DUNHAM	4256

8933 7590 11/03/2006

DUANE MORRIS, LLP  
IP DEPARTMENT  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103-4196

EXAMINER
----------

HAVAN, THU THAO

ART UNIT	PAPER NUMBER
----------	--------------

3691

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/035,890

Applicant(s)

NAGAN ET AL.

Examiner

Thu Thao Havan

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Detailed Action**

#### ***Response to Amendment***

Claims 1-10 are pending. This action is in response to the RCE received August 24, 2006.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al. (US 2003/0088489) in view of Segal (US 6,615,181).

Re claim 1, Peters teaches a method for assessing risks (para. 0003 and 0006; Peters assesses a client's investment profile and evaluates the risk dimensions of the client's current portfolio holdings) comprising:

creating a questionnaire containing a series of questions for prompting a user to supply information segmented according to risk areas, wherein the risk areas encompass categories of potential loss (para. 0012; figs. 2a (element 2116), 4a-4b, and 12; Peters

Art Unit: 3691

discloses risk assessment by having questionnaire in which the key questions seek to categorize the preferred risks);

providing a data store for recording data identifying user responses to the questions (figs. 2a, 3, and 4a-4b; Peters discloses a database for storing responses from user in relation to risk assessment);

programming a series of scoring rules containing an algorithm whereby the user responses are interpreted as indicating a predetermined level of risk at least as to categories of said potential losses (para. 0009-0013 and 0058, ; figs. 12 and 15; Peters discloses how expected return increases as risk increases in a programming algorithm);

presenting the questionnaire to a user and collecting the user responses in the data store (figs. 4a-4b and 14);

processing the user responses through the scoring rules and the algorithm to generate a report identifying risk levels according to the risk areas (para. 0007; figs. 15-17).

However, Peters does not explicitly teach legal and technological exposures in business practice, operational procedures, historical experience, compliance with regulations, and external threats including infrastructure failures and third party actions. On the other hand, Segal discloses legal and technological exposures in business practice, operational procedures, historical experience, compliance with regulations, and external threats including infrastructure failures and third party actions when he discloses different types of legal subject matters, professional liability claims, and insurance in relation to historical data or historic risk, insurance regulations, credible threats, and third party Database Computer System (col. 2, line 50 to col. 3, line 29; col.

8, lines 20-62; col. 12, lines 1-18; figs. 38-39b). He discloses the system for developing a set of criteria that could allow an objective determination of the qualification for benefits to be made, at least in the first instance, by a computer, based, e.g., on responses by the physician to a questionnaire developed for a purpose. He also discloses data processing map for the third party Database Computer System wherein the information reflects the quality of the book of business insured for counterclaim insurance. Thus, it would have been obvious to one of ordinary skill in the art to enable legal and technological exposures in business practice, operational procedures, historical experience, compliance with regulations, and external threats including infrastructure failures and third party actions for insurance in regulating policy as discloses in Segal.

Re claim 2, Peters teaches storing a series of recommendations associated with the risk areas, selecting among the recommendations as a function of at least one of the user responses and the risk levels identified by said processing step, and presenting selected ones of the recommendations in the report (para. 0006-0007 and 0016). Peters recommends specific portfolio changes based on asset classes to create an optimized portfolio for the client's investment profile.

Re claim 3, Peters teaches creating a database and storing the questions and the user responses for a plurality of users for comparison in risk assessments of future users (para. 0062; figs. 2a, 3, and 4a-4b).

Re claim 4, Peters teaches at least one of segmenting of the risk areas, creating the questionnaire and composing the algorithm comprises reliance on available data and judgment of professionals skilled in the risk areas (para. 0081).

Re claims **5-7**, Peter does not explicitly teach risks are selected from the group consisting of risk of a claim of loss due to computational deficiency, denial of service, security breach, violation of legal regulations, tort, contractual breach, insufficient capacity to meet contractual requirements, breach of commitment of confidentiality, violation of intellectual property rights, failure to adhere to multi-jurisdictional differences in regulation. Nevertheless, Peters discloses risks assessment can be used in other embodiments (para.0096). Thus, it would have been obvious to one of ordinary skill in the art to include different risks as questionnaires scenarios for the same result as in the method that discloses in Peters.

Re claim **8**, Peters teaches questionnaire requires selection among a limited set of possible answers and the algorithm quantifies risk based on each possible answer (fig. 4a). In figure 4a, Peters illustrates the claimed limitations.

Re claim **9**, Peters teaches questionnaire requires selection among yes/no and numeric answers (figs. 5 and 4a). In figure 5, Peters discloses yes/no answers and in figure 4a he discloses numeric answers.

Re claim **10**, Peters teaches questionnaire permits at least one of a missing answer and an answer indicating a lack of information, and wherein the algorithm assesses the risk levels as a function of said one of a missing answer and said lack of information (figs. 4a-4b).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3691

Ulwick, US 6,115,691

Geller et al. US 6,236,990

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH  
10/25/2006



HANI M. KAZIMI  
PRIMARY EXAMINER